UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/549,450	04/14/2000	Syed Zaeem Hosain	02556.P033X	8921

8791	7590	05/11/2006

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER
SHARMA, SUJATHA R

ART UNIT	PAPER NUMBER
2618	

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>05 April 2006</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>28-34 and 36-42</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>28-34 and 36-42</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed 4/5/06 have been fully considered but they are not

persuasive.

2.   The applicant argues that the amended claims 28,37 does not contain new matter i.e.

""the SID in the table identifying a cellular service provider that supports an application not

related to voice communications". Further, the applicant argues that the features of the claims 28

and 37 i.e. "performing a first detection process to detect support for the application not related

to voice communication" is not considered new matter. The applicant argues that the

specification on page 13-15 and page 41 have support for the amendment to the independent

claims 28,37.

The examiner respectfully disagrees. The examples cited by the applicant on pages 13-15

and pages 41 is general in nature and do not necessarily and specifically relate to non-voice

networks. For example, in vehicle theft scenario, the alarm triggers a microphone so that the

operator on the other side can listen to the situation. Also the same communication network that

is used for voice is also used to report the vehicle theft situation.

Further, the claims are not limited to the examples that the applicant has provided in the

specification. The term "not related to voice" encompasses all such applications such as SMS,

EMAIL, Instant Messaging, general alarm systems etc. None of these are disclosed in the

specification.

3.   The applicant argues that the secondary Reference Barber does not teach or disclose an

SID in a table that distinguishes a cellular provider that supports an application not related to

voice and further the applicant argues that Tendler also does not meet this limitation.

4.   In response to applicant's arguments against the references individually, one cannot show

nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re*

Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Here, Lynch discloses a method where the first SID matches a SID stored in the SID

table.

Barber reference is use to show the teaching where in case of emergency situation (see

col. 2, lines 49-67), services are provided if any SID that are not on the preferred list is received

by the cell phone meaning if low priority is determined not sufficient the preceding high priority

SID is used.

Tendler teaches a method where the emergency situation can be triggered using non-

voice communication for example by pressing a panic button. This teaching can then be used to

modify Barber to invoke a SID that supports non-voice communication.

Therefore the combination of Lynch, Barber and Tendler meet the limitations of the

claims 28 and 37.

Therefore the rejections of the claims 28 and 37 and the dependent claims as discussed in

the previous office action and as submitted below is considered proper.

5.   The prevailing issue in this case appears to be regarding the addition by amendment of

the negative claim limitations consisting of application or service *not* related to voice

communication. While there is no *in haec verba* requirement, newly added claim limitations

must be supported in the specification through express, implicit, or inherent disclosure. The

trouble is that there is no such disclosure, easy though it is to imagine it. Purdue Pharma L.P. v.

Faulding Inc., 230 F.3d 1320, 1328, 56 USPQ2d 1481, 1487 (Fed. Cir. 2000). The Examiner

does not question whether the claim language is inconsistent with, or contradictory to, the

teachings of the specification. But, the Examiner maintains that the specification does not

clearly and concisely disclose to the skilled artisan that the inventors considered *this particular*

feature, *i.e.,* application or service *not* related to voice communication, to be part of their

originally filed invention. There is therefore no force to the applicants' or affiant's arguments

that the written description requirement was satisfied because the *disclosure revealed a broad*

invention from which the later-filed claims carved out a patentable portion.

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

Claims 28 and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the

written description requirement. The claim(s) contains subject matter, which was not described

in the specification in such a way as to reasonably convey to one skilled in the relevant art that

the inventor(s), at the time the application was filed, had possession of the claimed invention.

The amended claim recites the limitation recites "the SID in the table identifying a cellular

service provider that supports an application not related to voice communications and further

performing a first detection process <u>to detect support for the application not related to voice</u>

<u>communication</u>" if support needs to be detected quickly

4.   The limitation underlined above is not disclosed in the specification and hence considered

to be new matter.

5.   Claims 29-34,36,38-42 are also rejected under 112, first paragraph since they are

dependent claims on the rejected base claims 28,37.

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claims 28,36,37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch

[US 5,586,338] in view of Barber [US 6,405,038] and further in view of Tendler [US 5,555,286].

        Regarding claims 28,36,37 Lynch discloses a method for determining whether a

particular service is provided by a cellular provider comprising:

-Reading a first identification number (SID) broadcast in a first frequency band where the first

SID identifies a cellular service provider (see abstract, col.8, lines 5-14);

-Determining whether the first SID matches a SID stored in a SID table (see col.8, lines 27-29

and lines 48-54);

-Switching to a second frequency and reading a second SID broadcast in the second frequency if

the first SID does not match a SID stored in the SID table (see col.9, lines 26-39, Fig.5);

-wherein the support for the particular cellular service is identified if the SID in the first or

second frequency bands matches a SID stored in the SID table (see col.2, lines 23-32), the first

and second frequency bands being cellular bands A and B (see col.8, lines 5-9).

Lynch, however, is silent to teach if low priority detection is sufficient and performing

high priority detection process if low priority is determined to be insufficient.

However Barber teaches a method of determining whether support for the particular

service needs to be detected quickly if neither the first or second SID is identified in the said

table and performing first detection (high priority) process if support for the particular service

needs to be detected quickly and performing a second detection (low priority) process if support

for the particular service does not need to be detected quickly . See summary of invention, col. 5,

line 15 – col. 6, line 4. Here Barber teaches a method where different priority levels can be

detected and also with each lower priority level detected, SIDs of preceding higher priority level

is not detected. However in case of emergency situation (see col. 2, lines 49-67), services are

provided if any SID that are not on the preferred list is received by the cell phone meaning if low

priority is determined not sufficient the preceding high priority SID is used.

Therefore it would have been obvious to one with ordinary skill in the art at the time the

invention was made to provide the above teaching of Barber to Lynch so that the 911 emergency

calls can be placed within areas where a new system selected is not available or if a new system

is available and not listed on the SID list.

However Lynch and Barber do not disclose a method wherein the emergency service is

activated without voice communication.

Tendler discloses a method wherein the emergency service is activated by pressing a

panic button on the telephone, which is then interpreted by the network as a high priority call.

Thus there is no voice communication in this situation when a panic button is depressed. See col.

2, lines 60-67; col. 3, line 60 – col. 5, line 35.

Therefore it would have been obvious to one with ordinary skill in the art at the time the

invention was made to provide the above teaching of Tendler to Barber and Lynch so that the

emergency service without voice communication can be placed within areas where a new system

selected is not available or if a new system is available and not listed on the SID list.

3.   Claims 29,30,38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch

[US 5,586,338], Barber [US 6,405,038] and Tendler [US 5,555,286] in view of Evans [US

6,311,060] and further in view of Roach [US 6,044,265].

Regarding claim 29, Lynch and Barber as treated in claim 28 do not disclose a method of

listening for cellular pages having an NPA value in a first frequency band, the NPA value

indicating that the cellular provider broadcasting in the first frequency band supports the

particular cellular service.

Evans teaches that a control message is referred to as a page and SID is carried in the

control channel (see col.2, lines 1-44).

Roach teaches a method of identifying the system identification (SID) by a NPA. Roach

further teaches the method of updating the SID table after a page is sensed in the said frequency

block. See column 4, lines 13-44.

It is apparent that Evans and Roach teach that listening for cellular pages having an NPA value in a first frequency band, the NPA value indicating that the cellular provider broadcasting in the first frequency band supports the cellular service.

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the above teachings of Roach and Evans to Barber and Lynch in order for an easy updating SID and informing the cellular set to add or remove the SIDs to the list.

Regarding claim 30, Lynch and Barber and Evans teach a method for determining whether a particular service supported by a cellular service provider comprising all the limitations as claimed. Evans further teaches if the cellular page is not detected in the first frequency band within a period of time, switching to a second frequency band (See Fig.9). Evans and Roach further teach that listening for cellular pages having an NPA value in a first frequency band, the NPA value indicating that the cellular provider broadcasting in the first frequency band supports the particular cellular service (See explanation treating claim 29).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the above teachings of Roach and Evans to Barber and Lynch in order for an easy updating SID and informing the cellular set to add or remove the SIDs to the list.

Regarding claim 38, Lynch and Barber as treated in claim 28 do not disclose a method of listening for cellular pages having an NPA value in a first frequency band, the NPA value indicating that the cellular provider broadcasting in the first frequency band supports the particular cellular service.

Evans teaches that a control message is referred to as a page and SID is carried in the control channel (see col.2, lines 1-44).

Roach teaches a method of identifying the system identification (SID) by a NPA. Roach further teaches the method of updating the SID table after a page is sensed in the said frequency block. See column 4, lines 13-44.

It is apparent that Evans and Roach teach that listening for cellular pages having an NPA value in a first frequency band, the NPA value indicating that the cellular provider broadcasting in the first frequency band supports the cellular service.

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the above teachings of Roach and Evans to Barber and Lynch in order for an easy updating SID and informing the cellular set to add or remove the SIDs to the list.

Evans further teaches if the cellular page is not detected in the first frequency band within a period of time, switching to a second frequency band (See Fig.9). Evans and Roach further teach that listening for cellular pages having an NPA value in a first frequency band, the NPA value indicating that the cellular provider broadcasting in the first frequency band supports the cellular service (See explanation treating claim 29).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the above teachings of Roach and Evans to Barber and Lynch in order for an easy updating SID and informing the cellular set to add or remove the SIDs to the list.

4.   Claims 31-34,39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Lynch [US 5,586,338], Barber [US 6,405,038] and Tendler [US 5,555,286] in view of Zicker

[US 5,159,625] and further in view of Evans [US 6,311,060].

Regarding claims 31,39, Lynch and Barber as treated in claim 28 teach all the limitations

as claimed. They are however silent to teach transmitting a page request packet in the first

frequency band to a host across a cellular network and receiving a cellular page from the host in

response to the page request packet thereby identifying the cellular service provider broadcasting

at the first frequency band as one which supports the particular cellular service.

However, Zicker teach the exchange of data between host and a remotely programmable

cellular mobile radiotelephone (CMR) (see col.5, lines 5-20 and Fig.1).

Evans teach transmitting and receiving a message/page in the first frequency band

between the MSC and the home system and the message indicates that the particular CMR has

registered in another cellular system and includes the SID and MSC number identifying the

foreign CMR system (see col.2, lines 1-44, col.11, lines 3-27, 55-67 and col.12, lines 1-3). It is

apparent that Lynch, Barber, Zicker and Evans teach transmitting and receiving a message in the

first frequency band to a host across a cellular network.

Therefore it would have been obvious to one with ordinary skill in the art at the time the

invention was made to provide the above teachings of Evans to modified Barber and Lynch in

order to collect billing information and bill the customer for using the home or foreign system.

Regarding claims 32,40, Lynch, Barber, Zicker and Evans as treated in claim 31 teach all

the limitations as claimed. Evans further teaches updating the SID table to include a SID of the

cellular service provider from which the cellular page was received (see col.11, lines 4-27 and Fig.9).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the above teachings of Evans to modified Barber and Lynch in order to facilitate roaming of the user to foreign system.

Regarding claims 33,41, Lynch and Barber as treated in claim 31 teach all the limitations as claimed. Evans further teach if the cellular page is not received within a pre-determined time, switching to a second frequency band and transmitting a second page request to a host across a cellular network, and receiving in response a cellular page from the host, thereby identifying the cellular service provider broadcasting at the second frequency band as one which supports the particular cellular service (see Fig.9).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the above teachings of Evans to modified Barber and Lynch in order to collect billing information and bill the customer for using the home or foreign system.

Regarding claims 34,42 Lynch and Barber as treated in claim 33 teach all the limitations as claimed. Evans further teaches updating the SID table to include a SID of the cellular service provider from which the cellular page was received (see col.11, lines 4-27 and Fig.9).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the above teachings of Evans to modified Barber and Lynch in order to facilitate roaming of the user to foreign system.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Sujatha Sharma whose telephone number is 571-272-7886. The

examiner can normally be reached on Mon-Fri 7.30am - 4.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Matthew D. Anderson can be reached on 571-272-4177. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sujatha Sharma
May 4, 2006

Matthew Anderson
SPE 2618